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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,497	07/19/2001	John W. Evans	97541.00007	9692
21832 7590 07/10/2007 MCCARTER & ENGLISH LLP CITYPLACE I 185 ASYLUM STREET HARTFORD, CT 06103			EXAMINER KHAN, AMINA S	
			ART UNIT 1751	PAPER NUMBER
			MAIL DATE 07/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/910,497

Applicant(s)

EVANS ET AL.

Examiner

Amina Khan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-13, 27, 40-42 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-12, 27, 40-42 and 44-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/16/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicant's amendment's filed on April 16, 2007.

2. Claims 1-3,6-13,27,40-42 and 44-50 are pending. Claims 4,5,14-26,28,29-39 and 43 have been cancelled. Claims 13,27,40 and 42 have been amended.

3. Claims 1-3, 6-12, 27, 40-42 and 44-50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (WO 96/37570) for the reasons set forth in the previous office action. The rejection of the claims is maintained.

### ***Allowable Subject Matter***

4. Claim 13 is allowed. Claim 13 is allowed over the prior art of record because the prior art does not teach non-aqueous heat transfer compositions comprising the claimed percentages of ethylene glycol and propylene glycol as claimed in claim 13.

### ***Response to Arguments***

5. Applicant's arguments regarding Evans (WO 96/37570) have been considered but they are not persuasive. The declaration under 37 CFR 1.132 filed April 16, 2007 is insufficient to overcome the rejection of claims 1-3, 6-12, 27, 40-42 and 44-50 based upon Evans (WO 96/37570) as set forth in the last Office action because: the prior art

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range of "at least 40% PG" leaving room for 60% or less EG and the instantly claimed "greater than 60% ethylene glycol" are not patentable distinct.

The applicant argues:

"The examiner's argument that there is a prima facie case of obviousness established because the range in Evans WO96/37570 is sufficiently close to the claimed range that one skilled in the art would have expected them to have the same properties is also misplaced. As explicitly stated in Evans WO96/37570 and in the Declaration of John Evans submitted herewith, one skilled in the art expected that a non-aqueous EG/PG heat transfer fluid could not contain more than 60% by weight ethylene glycol due to unacceptably high oral toxicity. As explained in the Evans Declaration, at the time of Evans WO96/37570, those skilled in the art believed that addition of EG to a heat transfer fluid would increase the toxicity of the fluid to unacceptable levels. Therefore, one skilled in the art did not expect that higher levels of EG in the heat transfer fluid would result in a fluid that had the same properties regarding toxicity. To the contrary, the expectation was that higher levels of EG resulted in unacceptably high toxicity. The presently claimed invention is based upon the unexpected discovery that non-aqueous EG/PG heat transfer fluids can contain greater than 60% EG with much lower oral toxicity than was expected or predicted."

The examiner asserts that the ranges of 60% and just slightly greater than 60% such as 60.0000001% would have similar properties. The examiner argues a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, see *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05I.

The applicant has not provided the spreadsheet as indicated in the declaration paragraph 6.

The examiner asserts that all disclosures of the prior art, including non-preferred embodiment, must be considered. See *In re Lamberti and Konort*, 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328 (CCPA 9173). Furthermore, nonpreferred embodiments can be indicative of obviousness, see *Merck & Co. v. Biocraft*

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*Laboratories Inc.* 10 USPQ 2d 1843 (Fed. Cir. 1989); *In re Lamberti*, 192 USPQ 278 (CCPA 1976); *In re Kohler*, 177 USPQ 399.

### **Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amina Khan whose telephone number is (571) 272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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*Am*

Amina Khan, PhD

July 6, 2007

*Lorna M. Douyon*

**LORNA M. DOUYON  
PRIMARY EXAMINER**